

REMARKS

Favorable reconsideration of this application is requested.

A Request for Continued Examination (RCE) accompanies this response, its entry thus being requested.

Claims 1 and 3-7 are in the case.

The interview kindly granted by the Examiner, Mr. Hendricks, on January 15, 2003 is herewith acknowledged with appreciation. It served to materially advance prosecution of the case by clarifying the issues.

With regard to the rejection of the claims under the first paragraph of 35 U.S.C. § 112, the above amendment to the claims clearly obviates this rejection. Specifically, the originally claimed percentage range of salt water has been reinserted and the criticized expression "about" has been deleted from the claims.

Withdrawal of the rejection of the claims under 35 U.S.C. § 112, first paragraph thus is requested.

With regard to the rejection of the claims under 35 U.S.C. § 103 as being unpatentable over Nagata et al, the following is submitted in traversal thereof.

The invention relates to a method for preparing a light colored seasoning liquid, comprising forming a Koji-making material comprising a raw material mixture comprising (a) a first component comprising 0-40% soybeans and (b) a second component comprising 60-100% gluten and wheat, wherein the gluten is present in an amount of 25-100%, the wheat is present in an amount 0-75% relative to the total of the gluten-containing second component, the percentages being on a dry weight basis, adding 7-24% salt water to said koji making material and subjecting the resulting mixture to fermentation by adding seed Koji, wherein the salt water is employed in a volume amount 1.35-1.50 times the weight of the raw

material mixture.

A feature neither disclosed nor made obvious by the reference is the use of the salt water in a volume amount of 1.35 to 1.50 times the weight of the raw material mixture. As is so evident from the results of Example 1 in the specification, when the volume amount of the salt water added is at most 1.50 times the weight of the raw material mixture, even more remarkable results are obtained with regard to JAS color code, total nitrogen (TN) content, glutamic acid (GLU) content and the amount of glutamic acid per unit amount of nitrogen. The result-effectiveness due to this claimed limitation is neither disclosed by, nor obvious from, the teaching of the reference. It rebuts any possible *prima facie* case of obviousness conceivably made out by Nagata et al. Note In re Antonie, 195 USPQ 6.

Further, it is to be noted and pointed out that reliance on examples in an application for claimed percentage ranges is permissible, providing for full support of a range based thereon. Note Ex parte Jackson, 110 USPQ 561. Also, the limitation of added claim 7 is not obvious from Nagata et al, the presence of soybeans being required by this reference.

Accordingly, withdrawal of the rejection of the claims under 35 U.S.C. § 103 is requested.

It is submitted that this application is now in condition for allowance and which is solicited.

Respectfully submitted,

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IN THE CLAIMS

1. (Twice Amended) A method for preparing a light colored seasoning liquid, comprising forming a Koji-making material comprising a raw material mixture comprising (a) a first component comprising 0-40% soybeans and (b) a second component comprising 60-100% gluten and wheat, wherein the gluten is present in an amount of 25-100%, the wheat is present in an amount 0-75% relative to the total of the gluten-containing second component, the percentages being on a dry weight basis, adding 7-[22]24% salt water to said koji making material and subjecting the resulting mixture to fermentation by adding seed Koji, wherein the salt water is employed in [an] a volume amount 1.35-[1.65] 1.50 times the weight of the raw material mixture.

3. (Twice Amended) The method for preparing a light colored seasoning liquid according to claim 1, wherein the fermentation is carried out for 2-3 months at 10°C; or for [about] one month at 10°C and subsequently for a further 1-2 months at 20°C.

5. (Amended) The method according to Claim 3, wherein the fermentation is carried out for [about] one month at 10°C and subsequently for a further 1-2 months at 20°C.

6. (New)

7. (New)

Ex parte Jackson, 110 USPQ 561 (BdPatApp&Int 1956)

Ex parte Jackson

(BdPatApp&Int)

110 USPQ 561

Opinion dated June 27, 1956

U.S. Patent and Trademark Office, Board of Patent Appeals and Interferences

Headnotes

PATENTS

1. Specification-Sufficiency of disclosure (§ 62.7)

Ranges of percentages of elements in claim are not arbitrary where they are based on all examples disclosed in application in which all elements recited in claim are present.

Particular patents-Alloy

Jackson, Magnesium-Lithium Base Alloy, claim 2 of application allowed.

Case History and Disposition:

Page 561

Appeal from Division 3.

Application for patent, Serial No. 43,057. From decision rejecting claim 2, applicant appeals. Reversed.

Attorneys:

Adams, Forward & McLean, New York, N.Y., for applicant.

Judge:

Before Wolffe, Duncombe, and Asp, Examiners in Chief.

Opinion Text

Opinion By:

Wolffe, Examiner in Chief.

This is an appeal from the final rejection of claim 2, the only claim remaining in the case. It reads as follows:

2. A magnesium-lithium base alloy, containing less than 0.1% of sodium, consisting of at least 66% of magnesium; from 1% to 13.5% of lithium; from 1% to 5% of silver; from 4% to 20% of cadmium; from 0.15% to 0.25% of zinc; from 0.05% to 0.2% of nickel; from 0.16% to 0.24% of copper; from 0.1% to 0.2% of barium; from 0.05% to 0.10% of calcium; and from 0.15% to 2% of aluminum.

No references have been relied upon.

The claim relates to magnesium-lithium alloys which contain at least about 66% of magnesium, from 1 to 13.5% of lithium and less than .1% of sodium. The composition of the claimed alloys is based on the following two discoveries: (1) that one or more of the alloying metals aluminum, cadmium, silver and zinc, when included in the above described magnesium-lithium base alloys, in amounts not appreciably greater than their solubility limits at ordinary temperatures, render the binary magnesium-lithium matrix work-hardenable and more creep resistant at room temperature; and (2) that the addition of small amounts of one or more "minor addition elements" including copper, calcium, nickel and barium, as well as many others, to the magnesium-lithium base alloy containing one or more of the

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alloying metals aluminum, cadmium, silver and zinc provides an alloy of improved stability when age-hardened.

Quite a number of examples are given on page 2A of the specification to illustrate the invention. The claim under consideration is directed to the magnesium-lithium base alloys disclosed on this page of the specification in which a combination of the alloying metals aluminum, silver, cadmium and zinc is present and in which each of the minor addition elements nickel, copper, barium and calcium is also present.

Claim 2 stands rejected on the sole ground that it is based on new matter. In this connection the examiner stated in the final rejection:

"More specifically it is held to be improper to arbitrarily set limits or ranges for the constituents of a composition when there is no proper coordination for such limits or ranges in the disclosure. Take for instance the range of '1% to 5% of silver' as now recited by the claim, the justification for this range should be found at page 2-A, wherein a number of examples are presented which include silver in succeeding whole numbers from 0 to 6. * * * In the case of the cadmium content there is even

less justification for the range of 'from 4% to 20%.' Isolated instances utilizing '4%,' '15%' and '20%' cadmium are not sufficient for arbitrarily assuming that all values between 4 and 20 would function in the composition in the manner applicant desires. In all probability they would and the assumption of a straight-line curve could be reasonably assumed. However in the event the curve were to dip at about 8% to 10% cadmium representing results diametrically opposed to applicant's but such values nevertheless would be covered, improperly so, by the present casting of the claim."

In his answer the examiner further stated:

"The claim includes additionally zinc, nickel, copper, barium, calcium and aluminum all of which now are represented by ranges in this claim, none of which are to be found to be disclosed as such in the specification. Page 2a of the specification is a table representing 15 specific alloys but nowhere are the ranges now claimed disclosed as such. Moreover, the reason for the ranges selected is not apparent from a study of page 2a. The values for silver and cadmium were mentioned in the final rejection letter as tending to indicate merely an arbitrary selection. There does not appear to be a satisfactory explanation in the brief that the ranges selected are not in fact arbitrary."

In support of the position taken by him the examiner cited *Ex parte Kingston*, patent file No. 2,394,919, and *In re Davidson*, 1941 C.D. 121, 47 USPQ 440 .

[1] We have considered the position taken by the examiner with care but we are constrained to hold that it is not sufficiently well founded. As indicated above the ranges recited in the present claim are based on all of the examples disclosed in the present application in which all the elements recited in the claim are present. These ranges, in contradistinction to the ranges recited in the claims ruled on in *Ex parte Kingston*, *supra*, are, therefore, not arbitrary. The situation in the present case is, in our opinion, similar to that in *Ex parte Kurtz*, patent file No. 2,600,995, where we held:

"It appears to us that since the Office places much emphasis on the disclosure of the examples which are present in the specification, it is ordinarily not improper to use all of the examples to set up a range of established operativeness. We find the decision in *Ex parte Kingston*, patent file No. 2,394,919, inapposite here, because in that case the new limits were not based on examples."

In re Davidson, *supra*, which is also relied on by the examiner to support his decision, is, in our opinion, not controlling here because in that case the claims as amended were held to be inconsistent with the original disclosure. This cannot be said about the claims presently before us.

As regards the range of cadmium recited in the claim the examiner admits that in all probability all values between 4% and 20% of cadmium "would function in the composition in the manner applicant desires," and that the assumption of a straight-line curve is reasonable. In view of this admission on the part of the examiner, it appears to us that the range of cadmium should not be objected to.

Accordingly, we will not sustain the rejection of claim 2 on the ground that it is based on

new matter.

The decision of the examiner is reversed.

- End of Case -